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No. 82-1223

In the Supreme Court of the United States

October Term, 1982

MINNESOTA MINING AND MANUFACTURING COMPANY,
Petitioner,

vs.

WALTER S. BLUME and THE ELECTRODYNE COMPANY, INC.,
Respondents.

ON PETITION FOR CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

REPLY BRIEF OF PETITIONER

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REPLY BRIEF OF PETITIONER

Respondent Blume, to escape review, pretends the case presents only questions of fact.

That is not so. No question of fact is involved.

The case presents two questions, each of which turns on a question of law, important to the patent law, which has not been, but ought to be, decided by this Court, *viz.*:

I. ONE CANNOT SELL A PATENT, AND AFTER POCKETING THE CONSIDERATION HE HAS NEVER OFFERED TO RETURN, ASSERT THE PATENT HE SOLD IS WORTHLESS, LEAVING HIM FREE TO MAKE AND SELL PRODUCTS COVERED BY THE PATENT HE SOLD.

Respondent Blume asserts the District Court examined the issue, analyzed the law, and the Court of Appeals affirmed without dissent.

The courts below applied the rule of *Lear, Inc. v. Adkins* (1959), 395 U.S. 653, allowing a *licensee* to attack the patent *licensed* to him.

The question here is *whether the same rule* applies to the *sale* of a patent.

That question this Court has never decided.

It ought to do so.

II. A PATENT MAY NOT BE ADJUDGED "OBVIOUS" ON THE GROUND ITS SEPARATE ELEMENTS MAY BE FOUND IN THE PRIOR ART; THE TEST OF "OBVIOUSNESS" REQUIRES THAT THE SUBJECT MATTER AS A WHOLE BE OBVIOUS AT THE TIME THE INVENTION WAS MADE TO A PERSON HAVING ORDINARY SKILL IN THE ART.

Respondent Blume says the District Court considered it (p. 8) "established overwhelmingly at trial that the Philips prior art *discloses every element*" of the claims in suit.

The question is *whether that is enough.*

The courts below thought it was.

The Second and Ninth Circuits hold it is not.

The decision below is in conflict with the Second Circuit's rule that "It is idle" to say that combinations of old elements cannot be inventions for, as Judge Learned Hand observed, "substantially every invention is for such a 'combination' * * *." *Reiner v. I. Leon Co., Inc.* (2d Cir., 1960), 285 F.2d 501, *certiorari denied* (1961), 366 U.S. 929, *rehearing denied* (1961), 366 U.S. 978. The decision is also in conflict with the Ninth Circuit rule, *Reeves Instrument Corp. v. Beckman Instruments, Inc.* (9th Cir., 1979), 444 F.2d 263, *certiorari denied* (1971), 404 U.S. 951, rejecting the argument here embraced by the courts below, that a patent is invalid if "the claimed invention consists of old elements * * *."

The governing rule on so important a point ought not to be left at large.

This Court should settle the issue.

The meritorious character of the invention in suit astonished Respondent Blume's expert Dr. Gerhard R. Hennig of Gauting, Germany. Blume would avoid this evidence on the pretense the witness was speaking of the *process* Patent '275 (which both courts below held valid and infringed) and not the *product* Patent '675 here in suit. The testimony of the witness discloses he was speaking *of the product.* He was astonished because he considered he knew everything about "*bonded magnets*;" he spoke of Blume's "*product*;" he obtained a sample of the "*magnet material*;" he found the properties *of the magnet* "quite good" and "just about as good as he said." (Petition for Certiorari, p. 9.)

CONCLUSION

This case presents two unresolved questions important to the patent law. The Court ought to take the case.

Respectfully submitted,

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